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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC SCOTT HODES, PAUL ROBERT KOLODNER,
TIMOFEI NIKITA KROUPENKINE, ALAN MICHAEL LYONS,
MARY LOUISE MANDICH, and JOSEPH ASHLEY TAYLOR

Appeal 2010-005994
Application 10/674,448
Technology Center 1700

Before CHUNG K. PAK, CHARLES F. WARREN, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's refusal to allow claims 1 through 6, 12, and 13, all of the claims pending in the above-identified application.¹ We have jurisdiction under 35 U.S.C. § 6.

¹ See Supplemental Appeal Brief ("App. Br.") filed July 13, 2009, 3; and Examiner's Answer ("Ans.") dated October 1, 2009, 2.

STATEMENT OF THE CASE

The subject matter on appeal is directed to an apparatus comprising a closed-cell nanostructured or microstructured surface (Spec. 3, ll. 15-28 and 8, ll. 4-20). The Specification, at page 8, lines 11-13, states that “[a]s used herein, the term closed cell is defined as a cell that is enclosed on all sides except for the side upon which a liquid is or could be disposed” as illustrated in Figure 6A and 6B in the above-identified application. Details of the appealed subject matter are recited in representative independent claims 1 and 5 reproduced from the Claims Appendix to the Appeal Brief as shown below:

1. An apparatus comprising:

a substrate having at least a first surface; and

a plurality of closed cells disposed in a predetermined feature pattern on said at least a first surface,

means for changing the pressure of at least a first fluid disposed within said plurality of closed cells in order to cause a selected liquid to change the degree of penetration of said feature pattern.

5. An apparatus comprising:

a substrate having at least a first surface; and

a plurality of closed cells disposed in a predetermined feature pattern on said at least a first surface,

means for changing the pressure of at least a first fluid disposed within said plurality of closed cells in order to cause a selected liquid to change the degree of penetration of said

feature pattern, wherein said means for changing the pressure of at least a first fluid comprises means for injecting and removing varying amounts of said fluid into and out of said cells, respectively.

As evidence of unpatentability of the claimed subject matter, the Examiner relies on the following sole prior art reference at page 3 of the Answer:

Lobert

US 4,750,693

Jun. 14, 1988

Appellants seek review of the following grounds of rejection set forth in the Answer²:

1. Claims 1 through 6 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Lobert; and
2. Claims 12 and 13 under 35 U.S.C. § 103(a) as unpatentable over the disclosure of Lobert. (*See App. Br. 7.*)

² Appellants also seek review of the objection of informalities in claims 1 and 5 at page 7 of their Appeal Brief. Although the Examiner has withdrawn the objection at page 7 of the Answer, we remind Appellants that a proper legal recourse to any objection is through a petition to the Director of the U.S. Patent and Trademark Office under 37 CFR § 1.181. *See In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002) (“There are a host of various kinds of decisions an examiner makes in the examination proceeding—mostly matters of a discretionary, procedural or nonsubstantive nature—which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner.”); *see also Manual of Patent Examining Procedure (MPEP)* §§1001.01, 1002, and 1002.02(c) (Rev. 2, May 2004).

PRINCIPLES OF LAW

The Specification “acts as dictionary when it expressly defines terms used in the claims or when it defines terms by implication.” *Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

When a claim recites means-plus-function limitations in accordance with 35 U.S.C. § 112, ¶ 6, they are interpreted as the corresponding structures, materials, or acts described in the Specification and equivalents thereof. *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (*en banc*).

The Examiner has the initial burden of establishing a *prima facie* case anticipation or obviousness under 35 U.S.C. § 102(b) or 1033(a). *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”).

Under 35 U.S.C. § 102(b), “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

RELEVANT FACTUAL FINDINGS, ISSUE, ANALYSIS, AND CONCLUSION

In rejecting the claims on appeal, the Examiner found that “Lobert teaches a device for reducing the frictional drag in a moving vehicle...[which comprises] a plurality of closed cells (grooves 10) disposed in a predetermined feature pattern on the last least first surface (the microstructure in Figures [(sic.)] 4a).” (*See* Ans. 3). The Examiner also

determined that the limitation “means for changing the pressure of a first fluid disposed within the plurality of closed cells...” recited in claims 1 and 5 is an inherent process limitation and “not germane to patentability in apparatus claim 1.” (*See* Ans. 4 and 5.) On the other hand, Appellants contend that the Examiner has not demonstrated that Lobert expressly or inherently teaches or would have suggested the limitations “a plurality of closed cells” and “means for changing the pressure of a first fluid disposed within the plurality of closed cells...” in claims 1 and 5 (*See* App. Br. 7-12.)

Thus, the dispositive question is: Did the Examiner err in finding that Lobert expressly or inherently teaches or would have suggested the limitations “a plurality of closed cells” and “means for changing the pressure of a first fluid disposed within the plurality of closed cells...” recited in claims 1 and 5 within the meaning of 35 U.S.C. § 102(b)? On this record, we answer this question in the affirmative.

As correctly stated by Appellants at pages 9 and 11 of the Appeal Brief, the claimed “closed cell” is limited to “a cell that is enclosed on all sides except for the side upon which a liquid is or could be disposed” and the claimed “means for changing the pressure of a first fluid disposed within the plurality of closed cells...” is limited to the corresponding apparatus structure described in the Specification or equivalents thereof. *Vitronics Corp.*, 90 F.3d at 1582; *Donaldson Co.*, 16 F.3d at 1193. Yet, the Examiner has not demonstrated, much less adequately explained, why and how Lobert teaches or would have suggested the claimed closed cells and means-plus-function limitation in question. (*See* Ans. 3-9.) The Examiner’s findings at pages 3 through 9 of the Answer do not adequately explain why the groove

taught by Lobert is deemed to be a cell that is enclosed on all sides except for the side upon which a liquid is or could be disposed as illustrated in Figure 6A and 6B in the above-identified application. (*Compare* Ans. 3-9 with App. Br. 10-11.) Nor does the section of Lobert relied upon by the Examiner disclose or suggest that its groove is enclosed on all sides except for the side upon which a liquid is or could be disposed. *Id.*

As also correctly argued by Appellants at page 11 of the Appeal Brief, the Examiner has not properly interpreted the claimed means-plus-function limitation in question as the corresponding structure described in the Specification or equivalents thereof consistent with the requirement of 35 U.S.C. § 112, paragraph 6. Nor has the Examiner identified a structure in Lobert's device which is identical or equivalent to or would have rendered obvious the structure corresponding to the claimed means-plus-function limitation in question as required by *Donaldson Co.*

If the Examiner's rejections based on Lobert are premised upon the interpretation of the claimed means-plus-function limitation as a process limitation due to no corresponding structure described in the Specification, we determine that the Examiner still erred in making such rejections since the Examiner's rejections are based on the erroneous construction of the means-plus-function limitation. As our reviewing court in *In re Aoyama*, No. 2010-1552, 2011 WL 3796243, at *5, 99 USPQ2d 1936, 1940 (Fed. Cir. 2011) stated:

[If] the means -plus-function limitation of claims...lacked sufficient disclosure of structure under 35 U.S.C. § 112, ¶ 6, these claims are unpatentable as indefinite under 35 U.S.C. § 112, ¶ 2 [and not anticipated under 35 U.S.C. § 102(b).]

Accordingly, we concur with Appellants that the Examiner has not carried the burden of establishing a prima facie case of anticipation regarding the subject matter recited in claims 1 through 6 within the meaning of 35 U.S.C. § 102(b) and a prima facie case of obviousness regarding the subject matter recited in claims 12 and 13 within the meaning of 35 U.S.C. § 103(a).

ORDER

In view of the foregoing, it is

ORDERED that the decision of the Examiner rejecting claims 1 through 6 under 35 U.S.C. § 102(b) and claims 12 and 13 under 35 U.S.C. § 103 is REVERSED.

REVERSED

kmm